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IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. 558

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE EIGHTH CIRCUIT AND BRIEF IN SUP-
PORT THEREOF.**

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Because of the Indefiniteness of the Claims the Courts Below Were Able to Ascribe to the Kesling Patent a Scope Capable of Embracing Every Shifter Mechanism Using Power and Capable of Producing a Function Called "Feel", Regardless of the Construction of the Mechanism or the Manner in Which It Functions to Produce "Feel", Though "Feel" Is Not Mentioned in the Patent or Argument Before the Patent Office	20
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PETITION FOR A WRIT OF CERTIORARI.

*To the Honorable, the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your Petitioner, General Motors Corporation, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Eighth Circuit to review the judgment entered by that Court, December 17, 1947 (R. 694-695) affirming the judgment of the District Court adjudging Petitioner guilty of infringement of claims 25 to 29 inclusive of United States Letters Patent No. 2,034,400, issued to Respondent, Elmer G. Kesling on March 17, 1936 (R. S35-646).

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (Title 28, U. S. Code, Sec. 347(a)).

The judgment of the Circuit Court of Appeals was entered December 17, 1947 (R. 694).

Opinion Below.

The opinion of the Circuit Court of Appeals appears in the Record at pages 671 to 694, inclusive, reported at 76 U.S.P.Q. 30.

The District Court rendered no opinion but entered Findings of Fact, Conclusions of Law and a Judgment, (R. 635-646) also reported at 66 F. Supp. 1 and 70 U.S.P.Q. 485.

Questions Presented.

1. Under the decision of this Court in *Halliburton v. Walker*,* 329 U. S. 1, do the claims of a patent satisfy the Patent Act (R.S. 4888; Title 35, U. S. Code, Sec. 33) when the novel element or "heart" of the combination claims is expressed in a general term (**actuator**) which appears nowhere in the patent specification and is defined only by the patent applicant's representations in argument to the Patent Office, and "no one of the claims has even suggested the physical structure of the" **actuator** and "no one of these claims describes the manner in which the (**actuator**) will operate together with the old" elements of the combination "so as to make the 'new' unitary apparatus perform its designed function"? (Quotations from *Halliburton v. Walker*, 329 U. S. 8.)
2. May a patentee who has represented to the Patent Office in order to secure allowance of claims over an earlier patent cited by the Patent Office, that his structure is such that it operates in a specific and distinguishing manner, subsequently, in an infringement suit to enforce the patent, repudiate those representations and assert a different and contradictory manner of operation to reach an accused structure which operates differently from the patented structure and more nearly like the structure of the earlier patent?

* Decided by this Court after submission of the instant case to the Eighth Circuit Court of Appeals, and not mentioned in the latter's opinion.

Reasons Relied On For Allowance of the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

1. The decision of the Circuit Court of Appeals in sustaining combination claims characterized by an assertedly "novel" element designated as an "actuator", a term of uncertain meaning not once used or defined in the specification, when the term is used in the claims without setting forth the structure or manner of operation of the "actuator", is in direct conflict with the decision of this Court in—

Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 13.

2. The decision of the Circuit Court of Appeals in failing to limit the claims in suit by applicant's representations made to the Patent Office to distinguish them from an earlier patent is in direct conflict with the decisions of several Circuit Courts of Appeals that such representations made in argument must be observed in construing patent claims.

Gottschalk Mfg. Co. v. Springfield Wire, 74 F. (2d) 583, 587 (CCA 1).

Ladd v. Walker, 7 F. (2d) 72, 76 (CCA 3).

Wiegand et al. v. Bingham Co., 106 F. (2d) 546, 548 (CCA 6).

Sager v. Glove Corp., 118 F. (2d) 873, 874 (CCA 7).

3. The decision of the Circuit Court of Appeals is in direct conflict with the decision of this Court in—

Permutit Co. v. Graver Corporation, 284 U. S. 51, 57-58.

4. The question presented by this petition is an important question with respect to the administration of the patent laws, as the decision of the Circuit Court of Appeals permits a patentee to take one narrow position with respect to the claims he seeks during the prosecution of the patent in the Patent Office, and thereafter to repudiate the necessary limitations of the claims as represented to the Patent Office and claim a far greater scope for the claims in asserting them against the public.

5. "The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope." *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U. S. 806, 816.

**Summary Statement of the Matter Involved.
In Brief.**

The five combination claims of the patent in suit contain a term, "actuator", not mentioned in the specification. Its only definition was in representations made in argument to the Patent Office to induce allowance of the claims. These representations were ignored by the Circuit Court of Appeals, which followed its earlier opinion in *Smith v. Mid-Continent Investment Co.*, 106 F. (2d) 622, 627, to the effect that statements by the applicant would not be considered "as the possible basis of estoppel".

The claims further lack any definition of the "actuator" or of "the structure, mode, and operation of the parts in combination," as required by this Court in *Halliburton Co. v. Walker*, 329 U. S. 1, 8. The Circuit Court of Appeals, although stating, "The heart of the combination is the actuator," satisfied itself with the statement, "Each of these claims states the physical combination of the various mechanical elements and their functional inter-relationship and operation" (R. 679).

The Circuit Court of Appeals found that the accused device was specifically different as to structure and function from that of the patent but found a functional correspondence in the production of each of a principle of operation called "feel" (see pages 19-21 below). The Court, although stating, "The patent nowhere contains the word 'feel'" (R. 682) held that because of this undisclosed teaching of "this governing principle * * * he (Kesling) is entitled to a reasonably liberal range of protection" (R. 686).

The sustained claims do not set out the connections between the elements necessary to produce "feel".

The Background.

Respondent, Kesling, invented a mechanism to aid in the manual shifting of gears in an automobile transmission, by which the operator performed the gear shifting in the conventional way until the gears were initially enmeshed and a conventional vacuum operated cylinder then took over and completed final movements of the gear shifter without further aid or control by the operator.

For years the standard automobile transmission contained an arrangement of gears to change the ratio of engine speed to rear wheel speed and to enable the car to be reversed (R. 209). This change was accomplished by manual movement of a gear shifter lever through a range of movements which make the letter H, thus—

Reverse	Intermediate
H	
Low	High

The transverse movement across the bar of the H selected one of two "rails", and movement along the legs of the H moved a shifter fork (in the patent called "shifter element") which brought a complementary pair or series of gears into meshing engagement. The engine was disconnected from the transmission during the shifting by operation of the clutch, and the connection was restored upon the completion of the shift by release of the clutch pedal (R. 35, 171-175).

Numerous patents appear in the prior art showing various devices for making the gear shift by vacuum power with manual or automatic control of the power (R. 330-337; R. 340-342; R. 388-392; R. 442-450).

Similarly several patents show the use of vacuum power to operate brakes on automobiles (R. 352-359; R. 367; R.

370-378; R. 380-383; R. 412-415; R. 418-422; R. 423-433), automobile steering mechanism (R. 436-439), and, as one patent says, "to provide a power actuator for the operation of brakes, gear shifts, clutches, steering gear, or other devices ordinarily operated manually, by hand or foot * * *" (R. 394-410, at 399).

As early as 1926, boat reverse gears had been operated by vacuum cylinder motors of the same type (R. 37, 45, 47).

The Moorhouse Patent No. 1,993,015 (R. 442-450; See Plate II at the back of this brief), applied for September 17, 1932, showed a vacuum cylinder power shifter for automobile transmissions. The manual shifter lever operated a valve through a control linkage by which, as long as the lever was moved in either direction, the vacuum cylinder was energized to move the shifter forks in the same direction. If for any reason the power was not available, the manual shifter lever did the shifting by hand with the same movement.

The Kesling Invention Was of a Gear Shifter in Which Manual Force Alone Was Used Initially to Engage the Gears and Thereupon Power Alone to Complete the Final Movements of the Shift Pursuant to a Timed Relationship Inevitable in His Structure.

Respondent's patented invention (R. 606-616) was of a device associated with the driver's manual operating lever and the transmission, by which the driver was able to make the shift in the conventional way until the complementary gear teeth initially enmeshed, whereupon a dump valve was relieved and a vacuum cylinder completed the shift in its final movement by power and without manual aid, or control.

The essential and critical features of Kesling's shifter lay in a structure by which the operator initially enmeshed the gears by manual force alone, and then released the vacuum power control valve which applied power *alone* to complete the shift. The operator had only manual force to move the gears (as well as the additional dead load of the inactive piston, piston rod, and associated parts) from neutral into initial engagement. He had no part in or control over the completion of the shift by power.

When the operator sought to shift from one gear (*e. g.* low), to another (*e. g.* intermediate or second), the operator was compelled to move the gears (and inactive piston, etc.) by manual effort alone from the old engaged position through neutral, and on until he had reengaged the gears in the newly selected position, whereupon the vacuum cylinder took over and completed the shift.

This is the only way the structure of the Kesling shifter can work. It is also the only structure and method of operation shown in the Kesling drawings and described repeatedly in his specification:

"Objects of the invention are to provide a gear shifting mechanism having manual means for imparting the initial movements thereto in shifting operation, and means for utilizing the operation of the engine or motor to impart the final movements to the shifting operations without the application of additional manual force to effect such final shifting movements; to provide a construction whereby the energy or force of the engine or motor will continue to operate or function without interruption until the shifting operation has proceeded to a predetermined extent;" (R. 611, col. 1, ll. 5-16.)

* * * * *

"Each of the cylinders 43 and 44 is equipped with valve mechanism controlling the ports 45 and 46 and

co-ordinated with the remainder of the invention in order to cause the engine or motor to impart the final movements to the shifting mechanism after the initial movements have been imparted to the shifting mechanism manually." (R. 612, col. 2, ll. 32-39.)

"Then the shaft 27 is moved longitudinally and the spindle 10 is turned thereby, thus imparting an initial lateral shifting movement to the fork 5 and an initial turning movement to the intermediate cam * * * to close the air inlet port 47 and to open the suction port 51.

"At this point the suction of the engine is from the cylinder 43, thereby operating the piston 40 to impart a final turning movement to the spindle 10, and thereby a final shifting movement to the fork 5 and the device operated thereby." (R. 613, col. 2, ll. 61-75; R. 614, col. 1, ll. 1-3.)

These and several other similar passages were in the Kesling specification as filed. The 20 claims originally filed were generally very specific and confined to the structural elements described in the specification, or the specific timed sequence of operations separating the initial manual operation from the final power operation, without manual aid or control (R. 91-105).

The word "actuator", which appears in each of the claims in suit, was first used by Kesling in his original claims 16-20 (R. 103-105). This term was nowhere mentioned or defined in the specification.

The Patent Office and Kesling agreed that this nebulous and undefined term referred to the unitary spindle and the cams and gears rigidly secured thereto (See Plate I at the back of this Brief), and that this structure necessarily produced the timed separation of the shift into an initial manual portion and a subsequent power portion without manual aid or control.

Throughout the Prosecution of His Application Kesling Consistently Urged That His Invention Distinguished From the Prior Art in the "Definite Timed Relationship" Between the Manual and Power Functions of His Shifter.

Prior to the insertion of the claims in suit Kesling had urged that his invention distinguished from the prior art then cited in the separation of the shifting operation into an initial manual portion and a subsequent power portion (R. 121, 135, 139).

On April 30, 1935, after the application had been pending about two years, the Patent Office cited the Moorhouse Patent No. 1,993,015 (R. 442-450) which had issued March 5, 1935, and was effective prior art to Kesling, and rejected a large number of claims previously allowed as fully met by Moorhouse.

Moorhouse (See Plate II) showed a shifter in which a conventional hand shift lever operated a valve control linkage to operate a valve producing a follow-up control of a suction motor which furnished the power to move the gear shifters. The suction power was applied throughout the movement of the shifters, always under full control of the hand lever. Whenever movement of the hand lever was halted the motor stopped.

The Moorhouse patent shows (See Plate II) a conventional gear box with shifter elements or forks, a control linkage or "actuator" comprising three interpivoted levers (colored red), a suction motor (yellow), a valve (blue), and a manual lever (27). The shifter elements, suction motor, valve and the manual lever are all connected to the control linkage so that the shifter elements are moved by the suction motor under the continuing control of the manual lever.

Moorhouse did not use manual force initially to engage the gears and thereafter uncontrolled power only to complete the shift.

Kesling urged this distinction in persuading the Patent Office that the Moorhouse patent was not applicable. When he added the six claims which issued as claims 25 to 30 inclusive, of which 25 to 29 are involved in this suit, he urged their allowance on the same ground of distinction from Moorhouse, saying:

"As to claim 15, Moorhouse does not disclose any operative combination of elements including manual mechanism for moving the shifter elements for only an initial portion of their movements and suction mechanism cooperating with said manual mechanism in timed relationship for imparting only the final movements to the shifter elements. Neither does Moorhouse disclose said manual and suction mechanism operating in the timed relationship mentioned in combination with means preventing operation of the suction mechanism until the manual mechanism has been operated to impart the initial movements to the shifter elements throughout their movements.

"Claims 16, 17, 18, 19 and 20 have been amended to include positively the suction mechanism that moves the devices operated thereby through *only* their final movements leaving it to the manual means to move said devices through their initial movements. Moorhouse does not disclose these elements combined and functioning in this way.

"Claim 23 has been similarly amended and claims 24 and 25, as amended, now distinguish from Moorhouse more clearly than before. The amendments inserted in said claims distinguish clearly from Moorhouse, which reference does not disclose the limitations brought into said claims by these amendments.

"The new claims are presented in view of Moorhouse and said claims include elements combined in a novel cooperative relationship and operating in a

novel timed relationship, clearly different from Moorhouse. That is to say, that said claims include manual means for moving the shifter elements initially and vacuum or power means brought into operation later, and after operation of the manual means, and in definite timed relationship to the operation of said manual means to move the parts through their final movements.

"In these particulars applicant's invention distinguishes quite clearly from Moorhouse and it is thought that the application, as now amended, is in condition for allowance which will be appreciated" (R. 159-161).

The "definite timed relationship" to which applicant referred was the same essential and critical feature of the Kesling device which had been emphasized and reiterated throughout the specification and the prolonged argument in the Patent Office, whereby manual force alone was employed to effect initial engagement of the gears and thereafter power alone employed to complete the shift. But, the claims adroitly adumbrated this clear distinction by using the undefined term "actuator" in each claim four or five times.

The Patent Office required a few formal changes and these were made, as Kesling said, "bringing in the valve whereby the actuator controls the suction mechanism to cause the suction mechanism to function at the proper time" (R. 165).

Thereupon the patent issued.

The Circuit Court of Appeals Recognized This Distinctive Feature in the Kesling Shifter, Whereby Manual Force Was First Used Alone to Make Initial Engagement of the Gears and Power Only to Effect Their Final Movement.

In its opinion the Circuit Court of Appeals repeatedly recognized not only the distinctive feature of the Kesling structure which induced the Patent Office to grant the Kesling patent, but also the inevitable difficulty that this involved in adding to the labor the operator was required to perform in the initial movements of the shift because of the unavoidable load the dead piston and related mechanism imposed. The Court said:

“The operation of this mechanism is as follows. Movement of the handle causes rotation of the spindle which is communicated to the cam causing its rotation. The rotation of the cam acts upon the shifter mechanism and also upon the power piston rod. Continued manual force causes further movements of the shifter mechanism toward the desired gear and of the piston rod toward the power valve. The results of this continued force by hand is that the gear shift gears are shifted to the point of initial meshing; at which time the valve becomes open; the power then takes over and pushes the gears into full mesh. The disclosures of the drawings and the Specification show that the preferred structure* contemplated use of manual force up to and into the beginning of the mesh with the desired speed gear and that, at that point, the vacuum power comes into play; takes over and completes the mesh” (R. 681).

* * * * *

“In Kesling's preferred form,* the hand begins and, without aid of power, carries the shifting operation to

* The patent nowhere mentions any other structure than the specific form shown or suggests that any alternative method of operation is desirable.

initial meshing with the desired speed ratio gear; at which point, power comes in and completes the mesh" (R. 693).

* * * *

"It is clear that Kesling *increases* the load of the 'initial' hand operation up to point of meshing gears to the extent of the 'drag' of the power unit pistons and that he *entirely relieves* the hand from any load in the 'final' operation of meshing the gears" (R. 674).

The Court's difficulty in giving the claims any precise scope arose from the presence of the undefined word "actuator."* After quoting the five claims in suit the Court said:

"Analysis of any of these claims reveals a combination mechanical structure composed of gear shift elements, manually operated elements, power operated elements and an 'actuator.' The heart of the combination is the actuator. To it, the shift, the manual and the power elements are all mechanically connected" (R. 679).

If the term "actuator", never defined in the patent, has any meaning in this case it is that given it throughout the case by Respondent and assumed for the purposes of discussion by Petitioner, the spindle with rigidly secured gears and cams colored in red on Plate II. As a connector

* That the term "actuator" has the loose, general meaning of such terms as "means" and "mechanism" appears from the following interrogation of defendant's engineering expert by plaintiff's counsel:

Thomas: " * * * The term seems to be very broad and means many things."

"Q. In other words, you certainly do not contend that an actuator cannot be made up of a group of parts that move relatively to each other?

"A. That is right, I do not; except an actuator probably could be called a mechanism or by some other term.

"Q. In other words, we might have substituted in our discussions here the term mechanism instead of the term actuator?" (R. 545)

between the hand levers, the suction valve (blue) and piston-driven rack (yellow), it necessarily established a "definite timed relationship" in the operation of the shifter because the gears, cams, etc., are secured together rigidly. The sequence of operation was invariable, and power was applied *only after* the hand alone had effected initial engagement of the gears.

The Accused Chevrolet Shifter Is Wholly Unlike the Kesling Device in Structure, Function and Result.

The Chevrolet gear shifter (See Plate II) employs a standard transmission with manual controls mounted on the steering wheel post. A suction motor is mounted adjacent the transmission and is controlled by a valve mounted within the piston rod.

A valve control linkage comprising three interpivoted levers, sometimes called a re-action linkage is interposed between the hand lever, piston, valve and the transmission shifter elements or forks. This valve control linkage is in principle that patented in the DeWandre Patent No. 1,869,956 (R. 424-433) where it is shown on power-operated brakes (See also R. 567). This linkage works on the same principle as the double-tree on a wagon, dividing the load between the hand lever and the piston, just as a double-tree divides the load to be borne by each horse of a team.

In the Chevrolet shifter the control linkage is so designed that the vacuum motor provides 80% and the operator 20% of the effort of shifting gears throughout the entire shifting operation. Because of the share of the effort constantly imposed on the operator, he is constantly aware of the progress of the shifting operation. Because a follow-up valve control is used (as in the Moorhouse

patent) the manual effort must be continuously applied or all movement stops. The District Court made a special finding on this:

"Defendant contends, and I am convinced it is true, that the proportion of force exerted by power is about 80%, and the proportion of force exerted by the hand is about 20%. The combined forces of the two bring about movement of the shifter lever. The hand, in operating the shifter lever, is the dominant influence in the operation and without the control by the hand throughout the operation, the operation would not be carried on, *i.e.*, the manual force dominates the mechanical force and whenever the movement of the hand stops, the operation in shifting the gears stops" (R. 640).

In the Chevrolet shifter (unlike Kesling) there is no time when the gear shifters are moved either entirely by hand or by hand before the suction motor is energized and active, no time when the power is effective without continued manual pressure upon the control levers. This method of operation is briefly described by the Circuit Court of Appeals:

"The method of operation of the accused device is as follows. Manual force initiates and continues throughout the entire shift operation. This manual force is first communicated to the valve lever which starts opening the valve port; continued manual pressure on the valve lever takes up any 'lost motion' clearance in the linkage between the valve lever and the reaction lever then causing movement of the reaction lever; still continued manual pressure takes up any 'lost motion' clearance in the linkage of the shifter lever then causing the shifter lever to start moving the gear shift elements; power force comes into exertion (through the piston rod connection to the reaction lever) upon the reaction lever and, through linkage, upon the shifter lever at least as early as the beginning of movement of the shifter lever; the com-

bined manual and power force continue the shifting movement to completion or until halted by withdrawal of manual force. The manual force is necessary not only to initiate the entire shifting operation but also continuously until the operation is completed. This is true because of the type of valve which activates the power unit. This is a 'follow up' type. This valve is positioned within a hollow piston rod so that, when the valve is opened, the thus admitted power causes the piston to move in the same direction as the valve is opening. If the hand pressure is stopped, the continued movement of the piston will close the valve port. Thus this hand pressure must be continued to keep the valve open and ahead of the piston movement or power force will be cut out. This manual control of the valve gives the driver complete control of the power; so that by continuing sufficient hand pressure, he can keep the valve port fully open, securing full force of the power unit; or by lessening the pressure, he can allow the port to close, shutting off power. It is not out of place to note that an entire gear shift operation is a matter consuming only seconds of time.

"Concisely, this method of operation is manual force admitting power force before any consequential movement of the gear shifting elements and, from there on throughout the entire normal gear shifting operation, a unison of manual and power forces with complete control in and mechanical connection with the hand of the driver—permitting 'feel'—up to completion of the gear shift" (R. 692-3).

Clearly in the Chevrolet shifter the suction mechanism and the manual mechanism do not operate in a "novel, timed relationship," as Kesling represented of his device and the claims in suit to the Patent Office when he said:

"That is to say, that said claims include manual means for moving the shifter elements initially and vacuum or power means brought into operation later, and after operation of the manual means, and in definite

timed relationship to the operation of said manual means to move the parts through their final movements" (R. 161).

It is clear why this is so. The Chevrolet shifter has no single unitary element forming an "actuator" to insure manual movement of the shifter elements prior to opening of the valve to produce Kesling's "timed relationship."

The control linkage in the Chevrolet shifter which Respondent asserts to be an "actuator" is composed of three levers pivoted together to permit them to move relatively to each other throughout their operation. Their respective positions are constantly altering. It is only through this continuing change in the relative positions of the control levers to each other that the valve is operated to insure constant control by the operator, and the load is distributed between the operator's hand and the suction motor, functions and results wholly absent from the Kesling structure. (The control linkage in the Moorhouse structure functions similarly, but because of the location of the pivots imposes no part of the effort of shifting on the operator).

Because of the Indefiniteness of the Claims the Courts Below Were Able to Ascribe to the Kesling Patent a Scope Capable of Embracing Every Shifter Mechanism Using Power and Capable of Producing a Function Called "Feel",* Regardless of the Construction of the Mechanism or the Manner in Which it Functions to Produce "Feel", Though "Feel" Is Not Mentioned in the Patent or Argument Before the Patent Office.

The trial court and the reviewing court conceded that the structures of the Kesling Patent and the Chevrolet gear shifter were different, that the sequences of operation thereof were different, and that the results accomplished thereby were specifically different.

But the trial court and the reviewing court concluded that both the Kesling construction and the Chevrolet construction have "feel" at the critical point of initial meshing of the gears. Only because of this functional similarity of the two constructions and because "the claims failed adequately to depict the structure, mode, and operation of the parts in combination," (*Halliburton Co. v. Walker*, 329 U. S. 8), was it held that the Chevrolet construction infringed the Kesling patent.

The specification of the Kesling patent and the arguments advanced before the Patent Office are completely silent on "feel". The presence of "feel" in the Kesling construction and its importance as a part of the Kesling patented invention were concocted for the first time at the trial of this case.

The function of "feel" has been present universally in

* "Feel" may be defined as the variation in resistance to movement encountered at different portions of the shifting operation. These variations follow a characteristic pattern and enable the operator, after becoming familiar with the pattern, to recognize immediately which of the several possible positions the gears occupy.

every manual gear shifter ever used. In the Kesling structure "feel" is present in the initial portion of the shifting movement only because shifting is purely manual at this time; as soon as power is applied, "feel" is destroyed. Thus "feel" and the specific "timed relationship" of the Kesling patent are completely interdependent; without one the other cannot exist.

In the Chevrolet construction, the "feel" is not that resulting from conventional manual shifting to the point of initial meshing of the gears, as in Kesling. The Chevrolet control valve linkage, through relative movement of its interpivoted levers, distributes the resistance to movement of the gear shifter elements between the hand lever and the suction motor. This makes the operator a sentient participant in the shifting operation through its full range of movement and reproduces for him, in miniature, the complete resistance pattern of normal manual shifting. "Feel" is the inevitable concomitant to power in the Chevrolet structure.

The Circuit Court of Appeals admitted that the patent did not mention "feel" (R. 682) but held that "because he (Kesling) uncovered this governing principle * * * he is entitled to a reasonably liberal range of protection" (R. 686).

The combination claims sustained do not set out the connections between the elements which are necessary in a structure to produce "feel", and the catalog of elements which forms each of these claims can be arranged in various ways to produce structures of the prior art as well as the Kesling structure, with or without "feel".

Not only are the combination claims mere catalogs of elements but one of those elements is the undefined "actuator".

These patent ambiguities in the claims are further ob-

scured by the refusal of the courts below to give effect to the only concrete expression of their meaning, that found in the argument made to the Patent Office which induced allowance of the claims.

The questions raised by combination claims of this type and the courts' refusal to consider the patentee's representations to the Patent Office as to their meaning are important questions in the administration of the patent law.

Wherefore, it is respectfully submitted that this petition be granted and a writ of certiorari be issued to the Circuit Court of Appeals for the Eighth Circuit.

Respectfully submitted,

HORACE DAWSON,
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Chicago, January 28, 1948.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1947.

No. _____

GENERAL MOTORS CORPORATION,

Petitioner,

vs.

ELMER G. KESLING,

*Respondent.***BRIEF IN SUPPORT OF PETITION FOR A
WRIT OF CERTIORARI.**

Patent Claims, Unlike Ordinary Contractual Instruments, Are Negotiated Without the Participation of Those Affected by Them, and to Insure That the Claims "Are Kept Within Their Legitimate Scope": It Is Imperative That the Claims Scrupulously Comply with All Representations Made to the Patent Office.

This Court, in a series of decisions culminating in *Mid-Continent Investment Co. v. Mercoid Corporation*, 320 U. S. 661, has established the limits of the economic scope of United States Letters Patent. The question of the technical scope of patent claims is of equal public importance and requires clarification of the effect of many of the accepted practices in the solicitation and interpretation of patent claims.

It has long been the established doctrine in this Court that a patentee who cancels claims from his patent or introduces limiting amendments into claims may not thereafter assert for those claims a scope coordinate with the cancelled claims or rejected and amended claims. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126.

This Court has similarly held that limiting material removed from a patent specification during its prosecution in the United States Patent Office would not be ignored in the interpretation of the patent claims. *Mackay Radio & Telegraph Company v. Radio Corporation of America*, 306 U. S. 86, 101.

This Court has impliedly gone farther in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, where it emphasized the effect of the argument of the applicant as bearing upon the construction to be accorded claims brought into litigation. While that case involved a reissue application in which the claims were amended during the prosecution, the Court six times referred to the meaning given to the claims by the applicant in his argument to the Patent Office (272 U. S. 437, 438, 440, 441 and 442).

The implication of these decisions is inescapable. Patents are "affected with the public interest" and because their "far-reaching social and economic consequences * * * give the public a paramount interest in seeing that patent monopolies * * * are kept within their legitimate scope," (*Precision Instru. Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U. S. 806, 816), it is important that this Court speak clearly and unmistakably upon the question of whether representations made in argument to the Patent Office to secure a patent are of substantial consequence in the interpretation of that patent when it is asserted.

The Circuit Courts of Appeals have been in irreconcilable conflict upon the question whether any weight should be

accorded to the argument made by an applicant in the Patent Office to overcome objections to the issuance of his patent.

"Some courts give consideration to arguments, as well as to cancellation, made in the office by the applicant, and even to statements made by the examiner; other courts refuse to consider such arguments or statements." (*Outline of Patent Law, Stringham, 1937*, p. 326.)

Some courts have looked upon a patent as merely a contract in which the negotiations and intent of the parties are merged in a final expression in the form of claims which may not be modified or interpreted by a disclosure of the negotiations which led to its expression, except by a comparison of altered or canceled claims with those issued.

"We take this occasion, however, once more to say that in the consideration of a file wrapper we do not look at the arguments of the applicant to the examiner. We wish it to be understood that, as we conceive the purpose for which the file wrapper can be examined, it covers simply the question of estoppels through rejected claims. The whole doctrine is somewhat anomalous at best, since it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions. The practice, however, is too well settled for us to disturb, and we have no intention of casting any doubt upon it. This court, nevertheless, has twice already disapproved the practice of bringing into that interpretation the arguments of an applicant. * * * We repeat now that disapproval."

Spalding v. John Wanamaker, 256 F. 530, 533-534 (C. C. A. 2, 1919).

"But the claim in suit does not limit the construction to a rotary valve, and the statement of the solicitor in the course of the Patent Office proceeding to this effect may not be carried into the claims allowed. It seems

likely that he had reference to claims subsequently rejected, which contained this limitation. Whether or not this was his meaning, it is the language of the claim, and not the argument of patent counsel which controls. Of course the claim as allowed must be read and interpreted with reference to the rejected claims, and to the prior state of the art, and cannot be construed to cover what was rejected by the Patent Office or disclosed by prior devices. *Doughnut Machine Corporation v. Joe-Lowe Corp.*, (C. C. A. 67 F. (2d) 135). On the other hand, the solicitors' arguments of themselves set up no estoppel."

Denominational Envelope Co. v. Duplex Envelope Co., 80 F. (2d) 186, 192. (C. C. A. 4, 1935.)

"Appellant relies upon certain rejection of claims by the Office and also upon certain statements of the Examiner and of the applicant. Under the rule above stated, we consider only the rejection and substitution of claims as the possible basis of estoppel."

Smith v. Mid-Continent Inv. Co., 106 F. (2d) 622, 627, (C. C. A. 8, 1939).

"The appellant relies on the rule recognized in the decision of this court in *Fullerton Walnut Growers' Association v. Anderson Co.*, 166 Fed. 443, 92 C. C. A. 295, that where the claims of a patent are not ambiguous they are not controlled or limited by any argument or representation made by the patentee's attorney before the Patent Office as to the scope of the invention or the features in which it differs from the prior art. But while admissions in the file wrapper may not be adverted to as enlarging or diminishing or varying the language of the patent thereafter issued, they have value in the present case as indicating the construction that should be put upon the claims."

Warren Bros. Co. v. Thompson, 293 F. 745, 747 (C. C. A. 9, 1923).

American Laundry Mach. Co. v. Strike, 103 F. (2d) 453, 456-457 (C. C. A. 10, 1939).

This Court in 1934, in *Keystone Driller Co. v. Northwest Engineering Corporation*, 294 U. S. 42, 48, where the question was not directly presented because the claims were limited during the prosecution so that a clear case of file wrapper estoppel was presented, stated:

"We do not attribute the force of an estoppel to what was said by the claimant in seeking to avoid the prior art cited against his broad claims, but we do apply the principle that where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the equivalent of those which were rejected."

Other courts have held the patentee to a scrupulous regard for the representations made to the Patent Office to secure the issuance of the claims.

"A patentee will not be permitted to repudiate a construction which he has put upon a claim in a communication to the Patent Office in order to obtain the allowance of it."

Gottschalk Mfg. Co. v. Springfield Wire, 74 F. (2d) 583, 587, (C. C. A. 1, 1935).

"With these repeated admissions of the Milne and Edgar disclosures and attempted avoidances thereof, Ritts is estopped from now claiming novelty in a high arch construction, so far as more height is concerned."

Ladd v. Walker, 7 F. (2d) 72, 76 (C. C. A. 3, 1925).

"We are aware that in some jurisdictions reference to file wrapper history to ascertain the meaning of claims is looked upon with disfavor except insofar as it covers the question of estoppel through rejected claims. *Spalding & Bros. v. Wanamaker*, 2 Cir., 256 F. 530. This is on the ground that it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial to the parties' intentions. We have not so tightly closed the door to inquiry upon the precise concept of the inventor measured by his own representations."

Wiegand v. Bingham Co., 106 F. (2d) 546, 548, (C. C. A. 6, 1939).

"The argument employed before the Examiner to obtain his patent—i.e., that the disclosure of a glove made from a single piece of material was a patentable improvement, defeats his contention of infringement by defendant's glove made from two pieces of material."

* * * * *

"By the argument, however, which induced the issuance of the patent, it is plain, so we think, that there is no infringement."

Sager v. Glove Corporation, 118 F. (2d) 873, 874, (C. C. A. 7, 1941).

In determining the acceptable line of authority on this question it must be remembered that the solicitation of patent claims is an *ex parte*, secret procedure in which the potential infringer, the manufacturer, the public, may never directly participate.

In soliciting his patent, Kesling repeatedly urged upon the Patent Office that his invention consisted in a mechanism providing a novel "timed relationship" with initial manual shifting followed by subsequent power shifting. He never attempted to distinguish the claims here in suit or other similar claims from the cited prior art on any other basis. His disclosed structure could operate in no other way.

From a reading of the Patent Office actions and the Kesling arguments there can be no doubt that both the Patent Office and Kesling so understood the claims when they were allowed. It was only upon this understanding, based upon Kesling's repeated representations that the Patent Office issued this patent.

Certainly the Patent Office did not allow the Kesling patent because it showed a mechanism providing "feel" when "feel" was never mentioned.

Yet in this suit, Kesling urged, and the Courts below held, that the "timed relationship", absent in the Chevrolet structure, could be completely ignored. "Feel", for which there was no definition to embarrass Kesling's expanding concept of his invention, suddenly became the "governing principle" of the Kesling invention because the Chevrolet shifter could not employ Kesling's "timed relationship" but did provide "feel", albeit of an entirely different type from that attributed to Kesling.

If a patentee may, as was done here, describe a single, specific structure in his patent specification, procure general, functional claims distinguished from the prior art only upon his representations of a specific and inevitable method of operation, then repudiate these representations and have the patent sustained as embracing all structures which possess an undisclosed, functional principle ("feel"), the statutory demand for a distinct claim of invention will be abrogated.

A Patent Claim, Unlike Other Contractual Instruments, May Not Have Its Ambiguities Resolved by a Reconstruction to Meet the Needs of Each Suit in Which It Is Asserted, But Must Satisfy the Statutory Demand That It "Distinctly Claim" the Invention.

While in some respects a patent may be like a contract, another important distinction must be ever present:

There is no statute to dictate that contracts, to be valid, must be expressed with a clarity beyond dispute. The patent statute dictates that a patentee shall—

"file in the Patent Office a written description" of his invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the

same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." (R. S. 4888; Title 35, U. S. Code, Sec. 33.)

The statutory command that a patentee "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery," is clear beyond any need for explanation or justification. This Court has repeatedly been compelled to invalidate patent claims for failure to comply with this elementary requirement.

There are many reasons besides the express terms of the statute why the demand for clarity in patent claims applies with special force to claims for a combination.

The entire concept of a patentable combination derives its vitality only from the arrangement of the elements in such a manner that the combination effects a new result and not merely the aggregate of the respective results of the respective elements. *John E. Thropp's Sons Co. v. Seiberling*, 264 U. S. 320, 326-327.

No mere catalog of elements can ever meet the requirement of a combination claim. If it could, the several elements indiscriminately connected could be made the subject of a patent claim. It is inconceivable that the law would tolerate a monopoly of such elastic scope.

A combination can be expressed only by a precise definition of the structure in which the elements are not only precisely named but their interconnections and manner of operation are established. Absent these limitations the catalog of elements does not depict a combination. *Halliburton v. Walker*, 329 U. S. 1, 8, 12.

There is nothing new in this principle. In 1879, in the case of *Parks v. Booth*, 102 U. S. 96, 102, this Court, in considering the statutory adequacy of combination claims said:

"Patented inventions are also made which embrace both a new device or element and a new combination of old devices embodied in the same apparatus or machine. Particular description of the improvement is required in such a case, as the property of the patentee in such a case consists not only in the new device, but also in the new combination."

"Modern inventions very often consist merely of a new combination of old elements or devices, where nothing is or can be claimed except the new combination. Such a combination is sufficiently described, to constitute a compliance with the letter and spirit of the Act of Congress, if the devices of which it is composed are specifically named, their mode of operation given, and the new and useful result to be accomplished is pointed out, so that those skilled in the art and the public may know the extent and nature of the claim and what the parts are which cooperate to do the work claimed for the invention."

We are confronted in this case with a patent which contains nothing but combination claims. Many of those claims are specific to the structure which Kesling produced and which he illustrated and described in his patent. With those claims we have no quarrel. They are not in suit.

The claims in suit, however, are merely catalogs of the following five elements:

1. "Gear shifter elements"
2. An "actuator" for moving the shifter elements
3. "Suction mechanism" or "operating means" for operating the actuator
4. A "valve" controlled by the actuator
5. "Other means" or "manual means" for moving the actuator.

Even were it possible to identify the specific structure purported to be designated by the word "actuator", there is nothing in these elements that insures that a structure comprising them will operate in the manner described in the Kesling patent and relied upon by the Circuit Court of Appeals as incorporating that nebulous, unmentioned principle of "feel".

Kesling's device has a specific timed relationship to which he repeatedly adverted in the Patent Office as distinguishing his structure from that of Moorehouse. That timed relationship can be established only if the "actuator" is solely manually controlled until the gears are initially enmeshed. There is no such limitation in any of the claims.

The structure shown in the Kesling patent inevitably produces a timed operation and that is the only reason the Kesling structure produces "feel". This result—the only new result attributed to Kesling—is present only because of the specific form of Kesling's so-called "actuator", and the specific arrangement of the elements of the combination. But the claims are wholly silent on these critical and vitalizing essentials.

The danger of mere catalog claims of the type here involved is evident from considering the variety of operations which would be possible by the indiscriminate arrangement of the combination elements which these claims permit.

The suction mechanism operates the actuator. The valve which regulates the suction mechanism is "controlled" by the actuator. How and when is the control exercised? Does the actuator open the valve which energizes the suction motor, or does it merely close the valve to stop the suction motor, or does it do both, and if so, when?

What are the "other means for initially controlling the actuator"? Where does the initial control begin and end?

What is the "actuator"? (See Plate I.) The patent specification not only fails to mention, identify or define it, but each of the claims mentions it four or five times and each time only in terms of either "what it will do" or what some other element will do to it.

"The language of the claim thus describes this most crucial element in the 'new' combination in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus."

Halliburton v. Walker, 329 U. S. 1, 9.

This brief need not elaborate the very complete statement of the principles enunciated in that opinion. Every defect which was found by this Court in the Walker patent is present here. In addition the claims contain the undefined term "actuator" without either the claims or specification "showing its structure, its working arrangement in the alleged new combination, and the manner of its connection with the other parts". (329 U. S. 8.)

The sweeping generality of the term "actuator" is instantly disclosed by the chart (Plate I) which shows in phantom the structures with which the Patent Office and court were concerned in this case. The specific device to which the term "actuator" must be applied in the patent; the Chevrolet device to which the term "actuator" was applied by the court; and the prior art (Moorhouse) device to which the inventor refused to apply the term in the Patent Office, are outlined boldly.

The promiscuity of the term is evident from the fact that in the Kesling patent the moving parts to which the name "actuator" must be applied are rigidly interconnected and have an invariable "timed relationship" in their operation, while both the accused and prior art structures possess a

control unit in which the inter-pivoted parts are in a constantly altering interrelationship.

How can a term of this versatility ever serve in a claim without violating the statutory command?

A term of such generality has immeasurable advantages for a patentee. He may, if the courts permit, apply the term to any device which moves. In this case the patentee has done just that. When it became evident that the Moorhouse patent responded to the express terms of his claims he overcame the difficulty by representing to the Patent Office—without incorporating any of the distinguishing limitations into his claims—that the structure performed in a specific way, producing a “timed relationship”. Having thus disposed of Moorhouse in the Patent Office the patentee shed these representations because they were not incorporated into his conveniently functional claims. Thus, in litigation, the claims readily lent themselves to a different and contradictory construction, defying any effort to interpret them literally or to ascertain any limits to which they might be subjected in the application of the doctrine of equivalents.

If the statute is to permit this verbal hocus-pocus it will have lost all meaning and the warning of this Court in *General Electric v. Wabash*, 304 U. S. 364, 369, become but a hollow echo:

“Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor

must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

The brief opinion of this Court in *Permutit v. Graver Corporation*, 284 U. S. 51, is directly in point. There a patent was sought to be enforced for a structure which allegedly was characterized by a " 'free' zeolite bed" which was neither mentioned in the specification nor in the claims although it was apparently indicated in the patent drawing. The trial courts had held, as the Circuit Court of Appeals did in this case (R. 682), that the novel feature was "necessarily 'presupposed' ", and the Sixth Circuit Court of Appeals held that if the structure shown involved a certain theory of operation it was not necessary that that be expressed. This Court bluntly rejected that approach and held (284 U. S. 51, 60) :

"The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. The free bed was neither described in the specification nor claimed in either Claim 1 or Claim 5."

The numerous other cases in this Court which invariably apply the statute (R. S. 4888; Title 35, U. S. Code, Sec. 33) need not be cited. The statute in its terms is clear. Its purpose is manifest. Its violation in this case is inescapable.

Conclusion.

The patent sued on in this case presents a sweeping departure from the simple demands of clarity which the Patent Act imposes.

The claims in suit are all combination claims, in functional terms, and built about the undefined and undefinable term "actuator" without depicting "the structure, mode and operation of the parts in combination."

The successful efforts of the patentee to overcome the prior art in the Patent Office by specific representations as to the functioning of the patented structure, if incorporated into the claims, might have saved them as they alone lent the required certainty to the claim terms. The repudiation of these representations was permitted by the doctrine of the Eighth Circuit Court of Appeals, in conflict with that of several other circuits which permit the patentee to shed himself of the effect of representations made to the Patent Office to secure the issuance of the patent, when the patent is later brought into court.

The ascription to the patent of an undisclosed and unmentioned functional principle "feel" as the test of infringement substitutes for the requirements of the law a tenuous and evasive standard which offers no guide to the public and makes the patentee's imagination, rather than the patent, the definition of the monopoly conferred upon him.

It is therefore respectfully urged that this Petition for Writ of Certiorari be granted.

Respectfully submitted,

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